

REMARKS

The present application was filed on December 21, 2001 with claims 1-19. A new claim 20 is added herein. Claims 1-20 are currently pending. Claims 1, 18 and 20 are the independent claims.

Applicants respectfully request reconsideration of the present application in view of the amendments above and the remarks below.

The Examiner has objected to the abstract as being of a length exceeding 150 words. Applicants have amended the abstract herein to reduce its length to below the 150 word limit. Accordingly, withdrawal of the objection is respectfully requested.

Claims 1-17 stand rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Apparently, the Examiner argues that the claims are indefinite simply because the claims utilize terms such as “configurable,” “configured” or “adapted to.” Applicants respectfully traverse. Usage of the terms in question is believed to be entirely appropriate in the context of the claimed invention.

Applicants initially note that the terms in question are not *per se* indefinite. For example, similar terms are addressed in MPEP §2106 in the context of computer-related inventions, but there is no indication therein, or elsewhere in the MPEP, that the mere use of such terms renders a given claim indefinite. Accordingly, MPEP §2106 does not provide a blanket prohibition against use of these or similar terms in all types of claims. Instead, it simply provides “examples of language that may raise a question as to the limiting effect of the language in a claim” directed to a computer-related invention.

It is interesting to note in this regard that MPEP §2106 indicates that some other examples of language that may raise a question as to limiting effect in claims directed to computer-related inventions include “wherein” clauses and “whereby” clauses. Is the Examiner arguing that the mere use of such clauses, or any of the other examples recited in MPEP §2106, automatically results in an indefinite claim? Such an argument strains credulity. There is absolutely no support whatsoever for the position that the mere use of terms such as “configurable,” “configured” or “adapted to” renders the corresponding claims indefinite.

Applicants would also like to point out that the Court of Customs and Patent Appeals, the predecessor to the Federal Circuit, has explicitly held that “adapted to” clauses and similar claim terms are permissible, and do not render a claim indefinite under §112, second paragraph. In re Venezia, 189 USPQ 149, (CCPA 1976).

A proper analysis under §112, second paragraph, must look at the claim as a whole to determine if the claim particularly points out and distinctly claims the subject matter that is regarded as the invention. If a given claim “define[s] the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, . . . [it is] definite as required by the second paragraph of section 112.” Id., at 151. Each of claims 1-17 is believed to meet this statutory requirement.

As an example, consider claim 17, which includes a limitation stating that the processor of claim 1 “is configured as an integrated circuit.” The Examiner in the Office Action at page 4 argues that the use of the term “configured” renders claim 17 indefinite because “it is not clear whether a processor configured as an integrated circuit is an integrated circuit or not.” Applicants respectfully submit that it is entirely clear that a processor configured as an integrated circuit is an integrated circuit. Any contrary conclusion would be in direct conflict with the explicit claim language, in that it is not possible to configure a processor as an integrated circuit without the processor being an integrated circuit. The other claims are believed to be similarly compliant with §112, second paragraph.

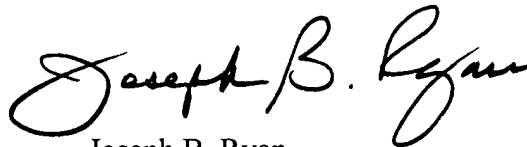
The Examiner has also rejected claims 1-17 under §112, second paragraph, on the ground that allegedly essential structural relationships between elements are omitted. Applicants respectfully traverse, on the ground that the claims as originally filed fully captured the essential structural relationships between the elements in question. Accordingly, the §112 rejection based on alleged omission of essential structural relationships is believed to be improper and should be withdrawn. Notwithstanding the traversal, independent claim 1 has been amended in a manner which is believed to address the concerns of the Examiner.

Claims 1-19 stand rejected under 35 U.S.C. §102(b) or §103(a) over U.S. Patent No. 5,720,032 (hereinafter “Picazo”). Applicants respectfully traverse, on the ground that the Picazo

reference fails to meet the particular claim limitations relating to first classification circuitry, scheduling circuitry and second classification circuitry. Notwithstanding the traversal, Applicants have amended independent claims 1 and 18, solely in order to expedite the prosecution of the application. Amendments have been made to the dependent claims to maintain consistency with amended claim 1, and a new claim 20 has been added. Support for the amendments can be found in the specification at, for example, page 5, line 7, to page 8, line 20.

In view of the above, Applicants believe that claims 1-20 are in condition for allowance, and respectfully request withdrawal of the §112, §102(b) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly legible.

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